

REMARKS/ARGUMENTS

Claims 1-22 are pending. By this Amendment, new claims 20-22 are presented, and claims 1-3 are amended. Support for new claims 20-22 can be found, for example, in FIGS. 2-4. Support for the amendments to claims 1-3 can be found, for example, in the present specification at page 13, lines 8 to 13, and in original claims 1-3. No new matter is added. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

Rejection Under 35 U.S.C. §112, First Paragraph

The Office Action rejects claims 1-3 and 7-15 under the written description requirement of 35 U.S.C. §112, first paragraph. Applicants respectfully traverse the rejection.

The Office Action asserts that the present specification fails to support the recitation of the "first portion", "second portion," etc., in the present claims. *See* Office Action, page 2. Applicants submit that these references were added to the claims to improve their clarity and are fully supported by the present specification. In the present claims, the bottom effluent of various apparatus are divided into different parts that are then conveyed to different locations. This aspect of the present invention is described throughout the original specification and claims as filed. *See, e.g.*, present specification, FIGS. 2-4. The assignment of the descriptors "first," "second," etc., to "portions" of the bottom effluent permits the separated parts to be identified with clarity when they appear later in a claim or in a dependent claim (so that there is no confusion about which "portion" is being discussed when the part is mentioned again later in the claims). The reference to the "first portion", "second portion," etc., does not introduce any new subject matter to the present application, but rather permits description of what is already present in the application with greater clarity. While the term "first portion,"

"second portion," etc., do not literally appear in the present specification, Applicants note that such literal support is not required. *See, e.g.*, MPEP §2163.

Claims 1-3 and 7-15 are fully supported by the specification as filed. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection Under 35 U.S.C. §112, Second Paragraph

The Office Action rejects claims 1-19 as indefinite under 35 U.S.C. §112, second paragraph. Applicants respectfully traverse the rejection.

The Office Action asserts that the present claims are indefinite because the claims do not explicitly indicate what happens to the "second portion" and the "fourth portion" of bottom effluent recited in the claims. The present claims make clear that the "first portion" and the "third portion" of the bottom effluent are recycled. Applicants have decided not to limit their claims to require that any particular action be taken with respect to the "second portion" and the "fourth portion" of the bottom effluent. The present specification describes embodiments in which streams corresponding to the "second portion" and the "fourth portion" are discharged. *See, e.g.*, present specification, FIGS. 2-4. However, the claims are not so limited, and need not be so limited. The Office Action appears to object not to the clarity of the claims, but rather to their breadth. As is well settled, breadth of a claim is not to be equated with indefiniteness. *See* MPEP §2173.04 (citing *In re Miller*, 169 U.S.P.Q. 597 (C.C.P.A. 1971)).

For the foregoing reasons, claims 1-19 are definite. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection Under 35 U.S.C. §102

The Office Action rejects claims 1-6, 10-12 and 16-19 under 35 U.S.C. §102(e) over U.S. Patent Application Publication No. US 2004/0171868 to Geisendoerfer et al. ("Geisendoerfer"). Applicants respectfully traverse the rejection.

Claim 1 recites "[a] process ... comprising: transesterifying methyl(meth)acrylate (A) with a higher alcohol (B) in the presence of a catalyst or catalyst mixture in the reaction apparatus; dividing a bottom effluent from the vacuum evaporation stage into a first portion and a second portion; and recycling the first portion to the reaction apparatus; wherein dividing the bottom effluent from the vacuum evaporation stage comprises selecting a proportion of the bottom effluent that will constitute the first portion based on current catalyst activity" (emphasis added). Claim 2 recites "...dividing a bottom effluent from the film evaporator into a first portion and a second portion ... wherein dividing the bottom effluent from the film evaporator comprises selecting a proportion of the bottom effluent that will constitute the first portion based on current catalyst activity" (emphasis added). Claim 3 recites "...dividing a bottom effluent from the film evaporator into a first portion and a second portion ... dividing a bottom effluent of the vacuum evaporation stage into a third portion and a fourth portion ... wherein: dividing the bottom effluent from the film evaporator comprises selecting a proportion of the bottom effluent from the film evaporator that will constitute the first portion based on current catalyst activity; and dividing the bottom effluent from the vacuum evaporation stage comprises selecting a proportion of the bottom effluent from the vacuum evaporation stage that will constitute the third portion based on current catalyst activity" (emphasis added). Geisendoerfer does not disclose or suggest such processes.

The Office Action concedes that Geisendoerfer fails to disclose or suggest selectively recycling a portion of a bottom effluent from a film evaporator and/or a vacuum evaporation

stage. *See* Office Action, page 5. However, the Office Action asserts that the claims do not require such selective recycling. *See* Office Action, page 5. By this Amendment, claims 1-3 are amended to explicitly recite that a portion of a bottom effluent from a film evaporator and/or a vacuum evaporation stage that is recycled to a reaction apparatus is selected on the basis of current catalyst activity. Accordingly, claims 1-3 distinguish over Geisendoerfer.

As explained, claims 1-3 are not anticipated by Geisendoerfer. Claims 4-6, 10-12 and 16-19 depend variously from claims 1-3 and, thus, also are not anticipated by Geisendoerfer. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection Under 35 U.S.C. §103

The Office Action rejects claims 1-19 under 35 U.S.C. §103(a) over Geisendoerfer. Applicants respectfully traverse the rejection.

For the reasons discussed above, Geisendoerfer fails to disclose or suggest a process in which a portion of a bottom effluent from a film evaporator and/or a vacuum evaporation stage that is recycled to a reaction apparatus is selected on the basis of current catalyst activity. Accordingly, Geisendoerfer fails to disclose or suggest each and every feature of claims 1-3.

As explained, claims 1-3 would not have been rendered obvious by Geisendoerfer. Claims 4-19 depend variously from claims 1-3 and, thus, also would not have been rendered obvious by Geisendoerfer. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

New Claims

By this Amendment, new claims 20-22 are presented. New claims 20-22 provide that recycled portions of a bottom effluent are directly recycled to a reaction apparatus – the

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recycled portions are not subjected to an intermediate work-up, as in Geisendoerfer.

Accordingly, new claims 20-22 are believed to be patentable.

Conclusion

For the foregoing reasons, Applicants submit that claims 1-22 are in condition for allowance. Prompt reconsideration and allowance are respectfully requested.

Respectfully submitted,

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